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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,021	11/02/2001	Lawrence J. Tarantino		6739

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Lawrence J. Tarantino
1423 Main Street
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EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/18/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/004,021	Applicant(s) TARANTINO ET AL.	
	Examiner Hai Vo	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-4 have been cancelled in the amendment received on 04/28/2003.

NEW MATTER

2. The amendment filed 04/28/2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:
“other suitable polymer materials having similar properties” and “a range of 24-128 kg/cubic meter in density may be utilized as well”. Applicants can’t change their specification to support the new matter. New matter must be excluded in the original disclosure and Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 5-8 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. EVA foam material is critical or essential to the practice of the invention, but it is not included in the claim(s) and therefore is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). As referred to page 2, line 3 of Applicant’s specification, “EVA is a closed cell, dense resilient foam that is unique in the field of present furniture

design applications.” From this description the specification seems to be requiring EVA closed cell foam.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claim preferably begins with the definite article “A” instead of “the” in US Patent practice. In Claim 5, line 1, “the” should be replaced by “A”. In addition, the phrase “is comprised of”, line 1, is preferably changed to --comprising--. Appropriate correction is required.

Suggested Language /Format

7. The examiner suggests that the claims should be rewritten in a manner as follows to avoid all the new matter and 112 issues, yet to reflect the disclosed invention.

Claim 5: A modularly designed furniture comprising slabs of ethylene vinyl acetate (EVA) foam having a density ranging from 35 to 45 kg/m³.

Claim 6: A modularly designed furniture in claim 5 wherein the EVA foam having a preferred density of 40 kg/m³.

Claim 7: A modularly designed furniture in claim 5 wherein the slab of the EVA foam is cut into a nested pattern and laminated to each other by an adhesive.

Claim 8: A modularly designed furniture in claim 7 wherein the slabs of EVA foam are formed to a specific size by band saw and grinded to a smooth finish.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Brichta et al (US 4,666,947). Brichta teaches a furniture formed from slabs of EVA foam having a density of 38 kg/m³ within the claimed range (column 1, lines 25-30, column 4, line 55). It is the examiner's position that Brichta anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brichta et al (US 4,666,947) in view of Pagni (US 5,240,528). Brichta is silent as to the slab EVA foam being cut into a nested pattern and laminated to each other by an adhesive. Pagni teaches a furniture piece 10 consisting of a plurality of stone tile members that are adhesively butt-joining to form planar panel members (figures

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1 and 3, column 3, lines 50-65). Pagni also teaches the larger panels comprising of a plurality of smaller tiles and being cut to the requisite size to form the different surfaces of the furniture object which is desired (column 3, lines 60-65). Pagni teaches the panel comprising a foam core to enhance the structural rigidity of the furniture piece (column 4, lines 14-20). In view with the teaching of Pagni, those skilled in the art at the time the invention was made will recognize that the plurality of EVA foam slabs may be sized and shaped in accordance with the desired furniture object to be constructed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to be motivated by the desire to join the EVA foam slabs to each other by the adhesive motivated by the desire to provide an adherence between them so as to form the different surfaces of the furniture object.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brichta et al (US 4,666,947) in view of Pagni (US 5,240,528) and Battaglia (US 4,822,661). Brichta is silent as to the slabs of EVA foam being formed to a specific size by band saw and grinded to smooth finish. Pagni teaches the panel being cut to the specific size to form the different surfaces of the furniture object which is desired and the surfaces being grinded to a smooth finish (column 3, lines 60-65, column 4, lines 13-14). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cut the slab of EVA foam to the specific size motivated by the desire to form the different surfaces of the furniture object which is desired.

Pagni does not specifically disclose the panels having been cut to a specific size by band saw. Battaglia teaches the panels having been cut to a specific size by band saw (column 2, lines 1-15). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a band saw to cut the panels because the band saw allows a far greater number of panels to be produced within a given period of time and thus greatly reducing expense of producing panels, which is important to the expectation of successfully practicing the invention of Brichta.

Response to arguments

13. The art rejections in Paper no. 2 have been overcome by the present amendment and response.
14. Applicant's arguments with respect to claims 5-8 have been considered but are moot in view of the new ground(s) of rejection.
15. The publication and commercial success have been reviewed and considered but they are not found persuasive to overcome the 103 art rejections above for the following reasons. The arguments that Applicants are successfully producing the invention for sale are not supported by an appropriate affidavit or declaration. Further no statistical analysis has been submitted to support in Applicants' assertions with respect to commercial success as stated by the inventors. Visit the web site, <http://www.uspto.gov/web/offices/pac/mpep/documents/0700.htm> (section MPEP 716.01 (c)). Applicants need to provide evidence of commercial success that must be factually supported by an appropriate affidavit in order to

overcome the finding of obviousness. Applicants also need to analyze and demonstrate why the commercial success of the presently claimed subject matter is sufficient to overcome the finding of obviousness.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
July 12, 2003



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700